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Application No. 10/692,545
Amendment dated January 16, 2007
Reply to Office Action of July 13, 2006**REMARKS**

Applicant has added new claims 121 and 122 to further define Applicant's invention.

The Examiner rejected claims 50-120 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,545,374 to Jacobson ("Jacobson") in view of American V. Mueller (Neurosurgical instrument, page 989) ("American V. Mueller"). As discussed below, Applicant traverses the Examiner's rejection because the combination of Jacobson and American V. Mueller, at the very least, cannot be maintained.

According to MPEP § 2142, to establish a prima facie case of obviousness under 35 U.S.C. § 103(a), the following three (3) basic criteria must be met:

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

"The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." (See MPEP § 2143.01). As such, references that do not contain any motivation to combine or modify can defeat a contention of obviousness under 35 U.S.C. § 103(a).

Applicant submits that the Examiner has failed to provide a prima facie case of obviousness in combining Jacobson and American V. Mueller. The Examiner has detailed the elements of the present invention that the Examiner indicates are not found in the knife of Jacobson. Thereafter, the Examiner indicates that "it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ a handle in view of American V. Mueller into Jacobson's device in order to provide a gripping portion conforming to (sic) surgeon's palm/hand." However, contrary to the Examiner's contention, no motivation exists to combine Jacobson and American V. Mueller.

The knife of Jacobson is best shown in Figs. 16 and 16A, and includes a handle 51, a shaft 52, and a serrated blade 53 or un-serrated blade 55 "attached to the

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shaft 52 opposite the handle 51." (See Jacobson, col. 10, lines 30-32). The knife of Jacobson uses a serrated blade 53 or un-serrated blade 55 in a back-and-forth, substantially linear motion to cut the disc material. That is, the knife of Jacobson is moved in two directions that are substantially parallel to the longitudinal axis of shaft 52. The device of American V. Mueller, as shown in Fig. 9, is a drill including a handle opposite a drill bit, and a hand crank used to rotate the drill bit. The handle is not used for rotation of the drill bit, but, instead, for stabilizing the drill and applying pressure in one direction on the drill bit.

Because the knife of Jacobson is adapted for back-and-forth linear motion and the handle of the drill of American V. Mueller is provided for stabilizing the drill and applying downward pressure on the drill bit, there would be no motivation to combine the references. Use of the knife of Jacobson runs contrary to the use of the handle of the drill of American V. Mueller. As such, the contrary uses of the knife of Jacobson and the handle of the drill of American V. Mueller do not provide motivation for a combination thereof. Therefore, the combination of Jacobson and American V. Mueller cannot be maintained. Accordingly, Applicant traverses the Examiner's rejection of claims 50-120 under 35 U.S.C. § 103(a).

Additionally, even if Jacobson and American V. Mueller were to be combined, independent claims 50, 58, 65, and 109 are patentable over such a combination. Claims 50, 58 and 109 recite "said arm having a longitudinal axis extending through said shaft and through said surface." Similarly, claim 65 recites "said arm having a longitudinal axis extending through said shaft and through said maximum height of said surface." The blade of Jacobson has a longitudinal axis that does not extend through the shaft; and thus, does not teach Applicant's invention as claimed in independent claims 50, 58, 65 and 109. Therefore, Applicant traverses the Examiner's rejection of claims 50, 58, 65, and 109 under 35 U.S.C. § 103(a) based on the combination of Jacobson and American V. Mueller.

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Applicant submits that independent claims 50, 58, 65, 93, 99, and 109 are patentable and that dependent claims 51-57, 59-64, 66-92, 94-98, 100-108, and 110-122 dependent from independent claim 50, 58, 65, 93, 99, or 109, or claims dependent therefrom, are patentable at least due to their dependency from an allowable independent claim.

In view of the foregoing remarks, it is respectfully submitted that the claims, as amended, are patentable. Therefore, it is requested that the Examiner reconsider the outstanding rejections in view of the preceding comments. Issuance of a timely Notice of Allowance of the claims is earnestly solicited.

To the extent any extension of time under 37 C.F.R. § 1.136 is required to obtain entry of this reply, such extension is hereby respectfully requested. If there are any fees due under 37 C.F.R. §§ 1.16 or 1.17 which are not enclosed herewith, including any fees required for an extension of time under 37 C.F.R. § 1.136, please charge such fees to our Deposit Account No. 50-3726.

Respectfully submitted,

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